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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/817,895	03/28/2001	Keiichi Onodera	041514-5116	9524

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MORGAN LEWIS & BOCKIUS LLP
1111 PENNSYLVANIA AVENUE NW
WASHINGTON, DC 20004

EXAMINER

PHAM, HAI CHI

ART UNIT	PAPER NUMBER
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2861

DATE MAILED: 06/01/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/817,895

Applicant(s)

ONODERA ET AL.

Examiner

Hai C. Pham

Art Unit

2861

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on RCE (04/27/05) & Amendment (03/07/05).
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 16, 19, 20, 22-31, 36-39, 42, 43 and 46 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 16, 19, 20, 22, 23, 26-31, 36-39, 42, 43 and 46 is/are rejected.
- 7) ☒ Claim(s) 24 and 25 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 06 July 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 04/27/05.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Request for Continued Examination

1. The request filed on 04/27/05 for a Continued Examination (RCE) under 37 CFR 1.114 based on parent Application No. 09/817,895 is acceptable and a RCE has been established. An action on the RCE follows.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

3. Claims 16, 19-20, 22-23, 26, 28, 36-39 are rejected under 35 U.S.C. 102(e) as being anticipated by Koyama (U.S. 6,556,234).

With regard to claim 19, Koyama discloses an apparatus and a method for writing a visible image pattern onto an unrecorded area of an optical recording medium, the apparatus comprising a driving part for driving the optical recording medium (inherent to the apparatus for writing a visible image pattern), and a writing part (the same laser as the recording means 13 or an additional laser scanning, not shown) (col. 3, lines 8-10) for forming a visible image pattern (7) by irradiating of light on a recording layer formed in the optical recording medium to generate a change in optical characteristic of the recording layer where pits are formed with the light as compared to a pit-less portion where pits are not formed (col. 4, lines 1-12), a data generating component (image processing box 9) for generating data of the visible image pattern to be formed in the recording layer of the recording medium, wherein said writing component modulates the light based on image pattern data generated by said data generating part and irradiates the modulated light on the recording layer (col. 3, lines 8-10), an editing component for editing the image pattern data generated by said data generating component (the image processing 9 processes the image pattern by varying the size and the number (col. 3, lines 44-46), a reading component for optically reading information already recorded in said recording layer of said optical recording medium, wherein said editing component detects an unrecorded area in said recording layer based on information read by said reading component or reflected light quantity from said optical recording medium and automatically edits image pattern data generated by said data generating component so that said image pattern matches to said detected unrecorded area (col. 3, lines 1-10 and lines. 42-50).

With regard to claim 20, Koyama discloses editing the image pattern data generated by said data generating component based on a table of contents (TOC) information or Absolute Time in Pre-groove (ATIP) information read by said reading component (the address of the location of the unrecorded area being contained in preformed grooves) (col. 3, lines 51-57).

With regard to claims 22 and 23, Koyama also teaches the editing component changes a resolution or size of the image pattern data when editing the image pattern data (the determined image pattern being edited to vary the size of the image pattern to fit into the unrecorded area of the recording medium) (col. 3, lines 42-50).

With regard to claim 26, Koyama teaches the same writing component being used to write data of the visible image pattern into the unrecorded data (6) and recordable data other than the data of the visible image pattern (e.g., information data) into the recording area (5) of the recording medium.

With regard to claim 28, Koyama teaches the recording means for recording information data onto the information recording area and an additional laser scanning for forming the visible image pattern in the unrecorded area of the recording medium (col. 3, lines 8-10).

With regard to claims 38 and 39, Koyama further teaches a detection component for detecting an unrecorded area of the optical recording medium (col. 3, lines 1-10), and the visible image pattern being constituted of characters, signs (7).

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 27, 29 rejected under 35 U.S.C. 103(a) as being unpatentable over Koyama in view of Kobayashi et al. (U.S. 6,754,158).

Koyama discloses all the basic limitations of the claimed invention except for the visible image pattern being written into the unrecorded data area using an enlarged spot size.

Kobayashi et al. discloses the optical and visual information being recorded into an optical recording medium, wherein a larger pit size in width or length is used to record the visual information so that the characters and figures can be visibly recognized (see Abstract and col. 17, lines 6-47) (Fig. 16).

It would have been obvious at the time the invention was made to a person having ordinary skill in the art to change the pit size in recording the visible image pattern in the device of Koyama as taught by Kobayashi et al. so that the characters and signs can be visibly recognized as suggested by Kobayashi et al.

6. Claims 31, 42-43 are rejected under 35 U.S.C. 103(a) as being unpatentable over Koyama in view of Nomura et al. (U.S. 4,967,286).

Koyama discloses all the basic limitations of the claimed invention except for the display component.

Nomula et al. discloses a method and apparatus for forming a digital image on a master optical recording medium, the apparatus comprising a driving component (mastering turntable 32) for driving the optical recording medium, and a writing component (laser 38) for forming a visible image pattern (18) by irradiation of light (laser beam) on a recording layer formed in the optical recording medium to generate a change in optical characteristic of said recording layer between a portion where pits are formed with the light and a pit-less portion where pits are not formed (the visible image 18 being formed by generating pits 26 on a background of pit-less reflecting surface 24, the pits creating visual effect, which contrasts markedly against the specular reflecting surface, e.g. difference in reflectance) (col. 3, lines 1-28). Nomula et al. further teaches a display component (video monitor 46) so as to display the edited visible image pattern.

It would have been obvious at the time the invention was made to a person having ordinary skill in the art to incorporate a display component in the device of Kobayashi et al. as taught Nomula et al. for the purpose of displaying and verifying the edited image pattern before recording.

7. Claim 46 is rejected under 35 U.S.C. 103(a) as being unpatentable over Koyama in view of Tsutomu (JP 59-215892).

Koyama discloses all the basic limitations of the claimed invention including the recording layer including an organic dye but fails to explicitly teach that it is either a cyanine dye or an azo dye.

Tsutomu, an acknowledged prior art, discloses the recording layer being formed from either one of a cyanine based organic dye and an azo based organic dye.

It would have been obvious at the time the invention was made to a person having ordinary skill in the art to provide the recording layer of Koyama with a cyanine based organic dye or an azo based organic dye as taught by Tsutomu. The motivation for doing so would have been to obtain a recording medium having excellent light resistance and a high reflectance as suggested by Tsutomu.

Allowable Subject Matter

8. Claims 24 and 25 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

9. The following is a statement of reasons for the indication of allowable subject matter: the primary reason for the indication of the allowability of claims 24 and 25 is the inclusion therein, in combination as currently claimed, of the limitation of prohibiting formation of the visible image pattern when the size or width of the unrecorded area of the recording medium is found smaller than the size or width of the visible image pattern, which is not found taught by the prior art of record considered alone or in combination.

Contact Information

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Hai C. Pham whose telephone number is (571) 272-2260. The examiner can normally be reached on M-F 8:30AM - 5:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David L. Talbott can be reached on (571) 272-1934. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



HAI PHAM
PRIMARY EXAMINER

May 28, 2005